

No. 17,848

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

ENGELHARD INDUSTRIES, INC.,

Appellant,

vs.

RESEARCH INSTRUMENTAL CORPORATION,

Appellee.

PETITION FOR REHEARING.

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Appellant.*

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*To the Honorable Koelsch, Circuit Judge, Hamley,
Circuit Judge, MacBride, District Judge:*

The appellant, Engelhard Industries, Inc., respectfully petitions for a rehearing to reconsider the judgment entered in this action on October 28, 1963.

The petition for rehearing in this matter is directed solely to the opinion of this Court wherein the District Court's decision is affirmed insofar as non-infringement is concerned.

1. The first ground urged for rehearing is the statement of this Court that the District Court was entitled to conclude "from the materials before it on the hearing for the motion for summary judgment, that the accused analyzer did not incorporate this distinctive feature of the invention" (*i.e.* "free area") on the cathode. The Court states that there "was nothing else in the record to counter the showing made by Research" relative to the affidavit of "one Lawlor, a physicist."

2. The second ground urged for rehearing relates to United States Patent No. 2,992,170 which issued after the date of the hearing (rather than before the date of the hearing as printed in Footnote 5); said patent contains statements made by Research through its Patent Attorney Lawlor contrary to the District Court's interpretation of subsequent alleged facts of the affiant Lawlor.

Considering now the first ground, the motion for summary judgment as filed by Research did not include any affidavit. However, the motion did refer to and did enumerate some twenty-one sets of documents including sworn admissions and interrogatories of record on this appeal [R. 90-92]. Subsequently, after Engelhard's answer to the motion, Research filed a reply brief including the affidavit of Lawlor, an attorney of record for Research in the District Court and patent lawyer for Research for a number of years [R. 197]. Counter-affidavits were not filed by Engelhard because the Lawlor affidavit raised no issue of fact not clearly controverted by sworn statements of Engelhard in the record prior to the motion hearing. (F. R. C. P. 56 not requiring opposing affidavits.)

The District Court considered *only* four requests for admissions and answers thereto in addition to the affidavit of Lawlor in formulating its conclusion of non-infringement [R. 249]; also, the District Court directed its attention only to the issue of file wrapper estoppel [R. 249]. Furthermore, only one of these four answers was related to the limited issue now before this Court of the "free area" on the cathode [R. 22—No. 256].

The District Court did not consider the answers to requests for admissions Nos. 254, 255, 259, 260 [R. 83 through R. 86]; furthermore, the District Court did not consider answers to requests for admissions Nos. 60, 61, 62, 63, 64, 65, 68, 69, and 86 [R. 22-R. 25 and

R. 32]. *Each of these sworn answers by Engelhard specifically denies that the cathode of the accused analyzer was totally covered with electrolyte.* These sworn statements are a part of the record relied upon by Research in its motion for summary judgment [R. 91, Items 4 and 5]. The sworn answer to request for admission No. 60 [R. 22], for example, specifically states that the cathode of the accused device has a portion free of electrolyte (See Appendix).

Thus, the only portion of the record which formed a basis for District Court's conclusion was the answer to interrogatory No. 256 [R. 83] and the Lawlor affidavit.

Considering answer No. 256, the District Court did not consider that moisture characterizes every device of this type and will form a thin film on the part of the cathode which is free of bulk electrolyte, and that this thin film is electrolytically conducting to a slight extent such that it may also be and was technically termed an electrolyte [R. 23, Answer No. 62, line 29, Patent No. 2,992,170, column 5, lines 30-35 of said patent and Hersch patent, column 6, lines 35-36].

The Lawlor affidavit is ambiguous since it states the electrolyte covers, which may mean rises by capillary attraction to the uppermost part of the cathode, rather than "envelopes" as this Court recognizes to be the proper term (first full para. p. 6 of Court's decision).

Thus, the District Court's conclusion of "no genuine issue of fact" was based only upon a technically ambiguous answer to a request for admission and a technically ambiguous affidavit of opposing counsel submitted in a reply brief and did not consider the numerous sworn statements to the contrary by Engelhard *in the record.*

In considering the second ground of this petition for rehearing, it is believed that the District Court erred and should further have granted appellant a rehearing on the basis of United States Letters Patent No. 2,992,170 which issued July 11, 1961, about three weeks after the hearing on the motion for summary judgment (June 19 and 20, 1961).

The patent clearly refers to a thin film of moisture covering the uppermost part of the cathode (Patent No. 2,992,170, column 5, lines 30-35) and to "menisci" on various portions of the cathode screen (Patent No. 2,992,170, column 9, lines 66-69; column 10, line 2; also appellant's brief, pp. 25 and 26). Menisci are well known in the art and cannot form unless there is a junction or boundary between a wetted part and a non-wetted part of a body. Thus, if "menisci" exist, then non-wetted parts or "free areas" characterize the cathode [R. 23, No. 61 and 62].

Accordingly, it is respectfully requested of this Honorable Court that appellant be given an opportunity to have a rehearing on the basis of the record now before this Court or supplemented if permissible with other portions of the certified record and the record before the District Court, but not made a part of the printed record on appeal because of the limited issue of file wrapper estoppel.

Undersigned counsel certifies that this petition is not interposed for delay and that in his judgment it is well founded.

Dated: November 22, 1963.

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Appellant.*

APPENDIX.

Statement No. 60. No part of the external surface of the cathode used by the defendants in the accused analyzer structure is free of electrolyte during the time said structure is being used for its intended purpose of measuring oxygen in an oxygen-bearing gas.

Answer No. 60. This is denied; the silver screen cathode of defendants' device is closely patterned after the silver screen cathode of the device shown to defendants' employee, Mr. McNamara, at Bayonne, and which appears in Figs. 4 and 5 of the patent in suit. Both of these silver screen cathodes have areas which will be damp as a result of pre-humidification, *but both are free of the electrolyte* with which other portions of the cathodes are in contact." (Emphasis added) [R. 22, 23.]

